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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,813	01/30/2006	David Casey	0789860222	8053
2392 7590 01/29/2010 FOLEY & LARDNER 555 South Flower Street SUITE 3500 LOS ANGELES, CA 90071-2411			EXAMINER LEE, JAE	
			ART UNIT 2895	PAPER NUMBER
			MAIL DATE 01/20/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,813

Applicant(s)

CASEY, DAVID

Examiner

JAE LEE

Art Unit

2895

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7, 8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 8, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/19/2009 has been entered.

Response to Arguments

2. Applicant's arguments with respect to **claims 1, 2, 3, 5, 7, 8, 10, and 11** have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. **Claim 5** is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the **claim 5** has not been further treated on the merits.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 1, 2, 3, 7, and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto (Pub No. US 2002/0024114 A1, hereinafter Sakamoto).

With regards to **claim 1**, Sakamoto teaches a bipolar transistor suitable for operation as a saturated switch comprising:

a first semiconductor region of a first conductivity type defining a collector region (see Fig. 1a, n collector region **21**);

a second semiconductor region of a second conductivity type defining a base region (see Fig. 1a, p base region **22**);

a third semiconductor region of said first conductivity type defining an emitter region (see Fig. 1a, n emitter region **24**); and

a metal layer providing contacts to said base and emitter regions (see Fig. 1a, metal layer **26+27** provided);

wherein the emitter region defines a first surface, the base region extending to said surface in locations defined by apertures through emitter region, said metal layer overlying said first surface (see Fig. 1a, emitter region **24** with first surface, base region extended through apertures through emitter region, metal layer from **26+27**),

wherein the bipolar transistor has a specific area resistance less than 500mOhms.mm² (see Remarks dated 10/19/2009, page 7, second paragraph, with the matrix design, possible to attain specific area resistance less than 500 mOhms.mm²);

Sakamoto, however, does not teach the thickness of said metal layer is greater than 3 microns.

In the same field of endeavor, it would have been obvious to one of ordinary skill to determine the optimum thickness (see *In re Aller, Lacey, and Hall* (10 USPQ 233-237)). It is not inventive to discover optimum or workable ranges by routine experimentation. Note that the specification contains no disclosure of either the critical nature of the claimed ranges or any unexpected results arising therefrom, but instead, discloses the METHOD criticality of yielding the benefit (i.e. gradually increasing thickness will generate lower voltage drops). In essence, the mere disclosure of a

thickness does not disclose this method criticality (i.e. its simply a thickness). Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical (see *In re Woodruff*, 919 f.2d 1575, 1578, 16 USPQ 2d 1934, 1936 (Fed. Cir. 1990)).

With regards to **claim 2**, Sakamoto does not teach a bipolar transistor according to **claim 1**, wherein the thickness of the metal layer is no less than 4 microns

In the same field of endeavor, it would have been obvious to one of ordinary skill to determine the optimum thickness (see *In re Aller*, *Lacey*, and *Hall* (10 USPQ 233-237). It is not inventive to discover optimum or workable ranges by routine experimentation. Note that the specification contains no disclosure of either the critical nature of the claimed ranges or any unexpected results arising therefrom, but instead, discloses the METHOD criticality of yielding the benefit (i.e. gradually increasing thickness will generate lower voltage drops). In essence, the mere disclosure of a thickness does not disclose this method criticality (i.e. its simply a thickness). Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical (see *In re Woodruff*, 919 f.2d 1575, 1578, 16 USPQ 2d 1934, 1936 (Fed. Cir. 1990)).

With regards to **claim 3**, Sakamoto does not teach a bipolar transistor according to any preceding claim, wherein the thickness of the metal layer is no less than 6 microns.

In the same field of endeavor, it would have been obvious to one of ordinary skill to determine the optimum thickness (see *In re Aller*, *Lacey*, and *Hall* (10 USPQ 233-237)). It is not inventive to discover optimum or workable ranges by routine experimentation. Note that the specification contains no disclosure of either the critical nature of the claimed ranges or any unexpected results arising therefrom, but instead, discloses the METHOD criticality of yielding the benefit (i.e. gradually increasing thickness will generate lower voltage drops). In essence, the mere disclosure of a thickness does not disclose this method criticality (i.e. its simply a thickness). Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical (see *In re Woodruff*, 919 f.2d 1575, 1578, 16 USPQ 2d 1934, 1936 (Fed. Cir. 1990)).

With regards to **claim 7**, Sakamoto teaches the bipolar transistor according to **claim 1**, wherein an increase in the thickness of the metal layer corresponds to a reduction in the voltage drop in the contacts to said base and emitter regions (this is a natural phenomenon that would happen inherently in nature; almost equivalent to a mathematical relationship; nevertheless, if this is a natural phenomenon, this will happen inherently).

With regards to **claim 8**, Sakamoto teaches the bipolar transistor according to claim 7, wherein the reduction in the voltage drop in the contacts is proportional to the increase in the thickness of the metal layer (this is a natural phenomenon that would happen inherently in nature; almost equivalent to a mathematical relationship).

8. **Claims 10 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto and further in view of Gardes et al. (Pub No. US 2003/0066184 A1, hereinafter Gardes et al.).

With regards to **claim 10**, Sakamoto teaches a method of manufacturing a bipolar transistor, the method comprising:

providing a bipolar transistor including a base region, an emitter region and a metal layer providing contacts to the base region and the emitter region, the bipolar transistor having a specific area resistance of less than 500 mOhms.mm² (see Fig. 1a, base, emitter, and metal layer providing metal contacts shown, see Remarks dated 10/19/2009, page 7, second paragraph, with the matrix design, possible to attain specific area resistance less than 500 mOhms.mm²);

Sakamoto, however, does not teach the metal layer having a 3 micron thickness and then subsequently increasing the thickness to a thickness greater than 3 microns.

In the same field of endeavor, it would have been obvious to one of ordinary skill to determine the optimum initial thickness (see *In re Aller, Lacey, and Hall* (10 USPQ 233-237)). It is not inventive to discover optimum or workable ranges by routine

experimentation. Note that the specification contains no disclosure of either the critical nature of the claimed ranges or any unexpected results arising therefrom, but instead, discloses the METHOD criticality of yielding the benefit (i.e. gradually increasing thickness will generate lower voltage drops). In essence, the mere disclosure of a thickness does not disclose this method criticality (i.e. its simply a thickness). Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical (see *In re Woodruff*, 919 f.2d 1575, 1578, 16 USPQ 2d 1934, 1936 (Fed. Cir. 1990)).

Also, in the same field of endeavor, Gardes et al. teaches how an increasing thickness of a metal layer will result in decreases in series resistance as well as a small voltage drop (see Fig. 1, ¶33).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to acknowledge that an increase of the metal layer for the contacts will result in decreases in series resistance as well as a small voltage drop as taught by Gardes et al.

With regards to **claim 11**, Sakamoto teaches the method according to **claim 10** wherein increasing the thickness of the metal layer to be greater than 3 microns comprises increasing the thickness of the metal layer to be no less than 4 microns.

In the same field of endeavor, Gardes et al. teaches how an increasing thickness of a metal layer will result in decreases in series resistance as well as a small voltage drop (see Fig. 1, ¶133).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to acknowledge that an increase of the metal layer for the contacts will result in decreases in series resistance as well as a small voltage drop as taught by Gardes et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAE LEE whose telephone number is (571)270-1224. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Richards can be reached on 571-272-1736. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jae Lee/
Examiner, Art Unit 2895

/N. Drew Richards/
Supervisory Patent Examiner, Art Unit 2895

JML